

REMARKS

I. Status of Claims

After the above amendments, claims 1-17, 19-21 and 23-36 are pending with claims 1, 19, 20, 30 and 32 being independent. Claims 32-36 have been newly added. No new matter has been introduced by way of the claim amendments or addition.

II. Response to Claim Rejections Under 35 U.S.C. §103(a)

Claims 1-17, 19-21 and 23-31 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,539,635 issued to *Larson, Jr.* (hereafter LARSON) in view of U.S. Patent No. 5,561,704 issued to *Salimando* (hereafter SALIMANDO) and further in view of U.S. Patent No. 5,666,528 issued to *Thai* (hereafter THAI). The Examiner asserted that the cited references disclose the various features recited in the claims. Applicant respectfully disagrees. However, in order to forward the present application toward allowance, Applicant has amended the claims to better define the claimed invention, specifically those features that differentiate the claimed invention from the cited references. Applicant respectfully submits that the cited references, taken either alone or in combination, fail to disclose, or even suggest the features presently claimed.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a prima facie case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Patent Office can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of references. *Id.* Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). That is, under 35 U.S.C. § 103, teachings of references can be combined only if there is some suggestion or motivation to do so. *Id.* However, the motivation cannot come from the applicant's invention itself. *In re Oetiker*, 977 F.2d 1443, 1447, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). Rather, there must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the art would make the combination. *Id.*

Regarding claim 1, Applicant has carefully considered LARSON, SALIMANDO and THAI in the context of 35 U.S.C. § 103 and submits that these references, taken either alone or in combination, fail to disclose, or even suggest:

receiving at least one user related broadcast identifier, wherein the received at least one user related broadcast identifier is not required to by itself identify a broadcast provider

and

wherein the identifying of the at least one broadcast provider does not require identifying only a closest proximity broadcast provider based on the received at least one user related geographic identification code (emphasis added)

More particularly, while the Examiner asserts that combination of LARSON and SALIMANDO renders obvious “receiving at least one user related broadcast identifier, wherein the received at least one user related broadcast identifier is not required to by itself identify a broadcast provider,” Applicant submits that the Examiner’s obviousness determination is based on impermissible hindsight reconstruction, and not on the objective teachings of LARSON and SALIMANDO. Moreover, Applicant submits that SALIMANDO fails to teach or suggest that “the identifying of the at least one broadcast provider does not require identifying only a closest proximity broadcast provider based on the received at least one user related geographic identification code.” In addition, THAI fails to make up for either of the above two deficiencies and a discussion related thereto will be omitted for conciseness.

Impermissible Hindsight

LARSON discloses a radio program distribution system that is adapted to interact with a customer through a telephone to facilitate the purchase of a compact disc including the radio program that the customer heard on the radio. As part of the telephonic interaction, LARSON’s radio program distribution system receives certain items of information from the customer in order to locate a data entry in a database that corresponds to a radio program the customer is interested in. The items of information consist of time, date and broadcaster and all three of time, date and broadcaster are required. Once received by the radio program distribution system, the system uses the three items of information to match a corresponding entry in a Broadcast Table (shown in Fig. 3). Once the corresponding entry in the Broadcast Table is located a

Reference Tag is obtained. The Reference Tag is then used to match a corresponding entry in a Program Table (shown in Fig. 2) which contains information about the radio program the customer is inquiring about.

In LARSON's radio program distribution system, the system requires that the information received from the customer include all three items of information, namely the time, date and broadcaster. The system only has a single entry in the Broadcast Table for any given combination of time, date and broadcaster. With respect to the broadcaster information received from the customer, LARSON teaches that either the broadcaster identity is received from the customer or the customer selects the broadcaster identity through a menu. In either case, when the customer provides the broadcaster identity to the system, the provided broadcaster identity by itself identifies the broadcaster.

In contrast, claim 1 recites "receiving at least one user related broadcast identifier, wherein the received at least one user related broadcast identifier is not required to by itself identify a broadcast provider." Since LARSON's system operates under the assumption that the provided broadcaster identity by itself identifies the broadcaster, there is no need in LARSON's system to be able to receive broadcaster information from a user that is not required to by itself identify the broadcaster. Accordingly, LARSON's system does not include any capability for the receipt of broadcaster information from the customer that is not required to by itself identify the broadcaster. Instead, LARSON's system uses the exact broadcaster identity provided by the customer to match the appropriate entry in the database. If LARSON's system received broadcaster information that is not required to by itself identify the broadcaster, the system will not be able to locate an entry in the database since there will be no direct match between the received broadcaster information and the broadcaster identity used in the database. Accordingly, LARSON fails to teach or disclose "receiving at least one user related broadcast identifier, wherein the received at least one user related broadcast identifier is not required to by itself identify a broadcast provider."

To make up for the above-mentioned deficiency in LARSON, the Examiner cited SALIMANDO. SALIMANDO discloses a proximity based toll free communication service that is adapted to interact with a user of a mobile communication system through the user's mobile telephone to facilitate the a communication between the user and a closest service provider that

matches a type of service provider the user desires to communicate with. As part of the telephonic interaction, SALIMANDO's proximity based toll free communication system receives certain items of information in order to identify the closest service provider that corresponds to the type of service provider the user wishes to communicate with. The items of information include at least location information of the user and a service request identifier. Once received by SALIMANDO's system, the two items of information are used to identify the closest service provider that is associated with a service request identifier that matches the service request identifier input by the user. After the closest matching service provider is identified, the user is either automatically connected to the service provider or the user is provided with contact information for the service provider.

Applicant submits that the above combination of LARSON and SALIMANDO is based on impermissible hindsight reconstruction, and not on the objective teachings of LARSON and SALIMANDO. Applicant submits that "[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination." *Id.* at *29-30 (citing In re Beattie, 974 F.2d 1309, 1311-12, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992)).

In this case, the Examiner's combination appears to be a combination of generalizations from LARSON and SALIMANDO that are divorced from the specifics of their teachings and suspiciously fit together so as to formulate something that resembles the Applicant's claim 1. However, even the generalizations of LARSON and SALIMANDO do not lend themselves to be combined in a manner consistent with claim 1. LARSON teaching is directed toward facilitating the purchase of a compact disc including a radio program that a customer heard on the radio. LARSON addresses the problem of user convenience in the purchasing of a compact disc including a radio program. In contrast, SALIMANDO is directed toward facilitating a communication between a mobile user and a closest service provider matching a type that the user desires to communicate with. SALIMANDO addresses the problem of providing a mobile user with closest proximity information based on the user's location. One of ordinary skill in the art would not arrive at the above identified feature of claim 1 based on LARSON and SALIMANDO absent hindsight reasoning.

Furthermore, the Examiner has not identified or suggested how one might blend all of the various concepts in LARSON and SALIMANDO. Accordingly, it is clear that the Examiner's combination fails to consider the objective teachings of the prior art as a whole and instead uses the Applicant's teaching as a roadmap for picking and choosing generalizations from LARSON and SALIMANDO to formulate something that resembles the Applicant's claim 1. Therefore, it is clear that the Examiner's combination can only be based on impermissible hindsight reconstruction.

Feature not Taught or Suggested

Furthermore, Applicant submits that SALIMANDO fails to teach or suggest that "the identifying of the at least one broadcast provider does not require identifying only a closest proximity broadcast provider based on the received at least one user related geographic identification code." In contrast, SALIMANDO teaches that the identification of the service provider requires identifying a single service provider that is closest in proximity to the user. Clearly, SALIMANDO fails to teach or suggested the above identified feature and neither LARSON nor THAI make up for SALIMANDO's deficiency.

Under 35 U.S.C. § 103, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). As stated in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). That is, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 165 USPQ 494, 496 (CCPA 1970). Therefore, is it respectfully submitted that the combination of LARSON, SALIMANDO and THAI fails to establish a *prima facie* obviousness of claim 1.

Therefore, for the above stated reasons, claim 1 is allowable over LARSON, SALIMANDO and THAI. Should the rejection of claim 1 be maintained, the Examiner is respectfully requested to articulate in detail how LARSON, SALIMANDO and THAI are being interpreted to anticipate the above identified features of claim 1.

Regarding claims 2-17, 28 and 29, these claims are dependent upon independent claim 1. Thus, since independent claim 1 should be allowable as discussed above, claims 2-17, 28 and 29 should also be allowable at least by virtue of their dependency on independent claim 1. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

Regarding independent claims 19, 20, 30 and 36, these claims recite subject matter related to claim 1. In particular, claim 19 recites:

wherein the at least one user communication comprises at least one user related broadcast identifier that is not required to by itself identify the at least one broadcast provider

and

wherein the identifying of the at least one broadcast provider does *not* require identifying only a closest proximity broadcast provider based on the received at least one network address (emphasis added)

Claim 20 recites:

wherein said received at least one user related broadcast identifier is not required to by itself identify a broadcast provider

and

wherein the identifying of the at least one broadcast provider does *not* require identifying only a closest proximity broadcast provider based on the received at least one user related geographic identification code (emphasis added)

Claim 30 recites:

wherein the received at least one user related content provider identifier is not required to by itself identify a content provider

and

wherein the identifying of the at least one content provider does *not* require identifying only a closest proximity content provider based on the received at least one user related geographic identification code (emphasis added)

Claim 36 recites:

wherein the received at least one user related broadcast identifier is not required to by itself identify a broadcast provider

and

wherein the identifying of the at least one broadcast provider does *not* require identifying only a closest proximity broadcast provider based on the received at least one user related geographic identification code (emphasis added)

Thus, the arguments set forth above with respect to claim 1 are equally applicable to independent claims 19, 20, 30 and 36. Accordingly, it is respectfully submitted that independent claims 19, 20, 30 and 36 are allowable over LARSON, SALIMANDO and THAI for the same reasons as set forth above with respect to independent claim 1.

Regarding claims 20-21, 23-29 and 31-35, these claims are dependent upon independent claims 19, 20, 30 and 36. Thus, since independent claims 19, 20, 30 and 36 should be allowable as discussed above, claims 20-21, 23-29 and 31-35 should also be allowable at least by virtue of their dependency on independent claims 19, 20, 30 and 36. Moreover, these claims recite additional features which are not disclosed, or even suggested, by the cited references taken either alone or in combination.

III. Conclusion

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

It is believed that no additional fees are due in connection with the filing of this Amendment. However, please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-4100, and please credit any excess fees to the same deposit account.

Respectfully submitted,

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